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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,894

09/11/2003

Sebastian Vogt

100727-57/Heraeus
409-KGB

4182

27384

7590

07/10/2006

EXAMINER

ROGERS, JAMES WILLIAM

NORRIS, MCLAUGHLIN & MARCUS, PA
875 THIRD AVENUE
18TH FLOOR
NEW YORK, NY 10022

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/659,894	Applicant(s) VOGT ET AL.	
	Examiner James W. Rogers, Ph.D.	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 2,4-13 and 15-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/03/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of group II claims 1,3 and 11-14 in the reply filed on 06/12/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Examiner also notes the species elected by applicant in the reply filed on 06/12/2006. Regarding the election of the hydrophobic and hydrophilic antibiotics (Gentamicin palmitate and Gentamicin sulfate) these are not species claimed in claims 1,3 and 11-14, therefore the election of these species was improper. Also the election of the hydrophilic polymer PEG600 and the organic ancillary sulfamethoxazole were also not previously claimed in claims 1,3 and 11-14, therefore the election of these species was improper. In order to expedite the examination process the examiner searched the genus of the species Gentamicin palmitate and Gentamicin sulfate, namely aminoglycoside antibiotics which was claimed and for the hydrophilic polymer the examiner searched for the broader genus PEG. The organic ancillary substance is noted as being an optionally component therefore it does not further limit the claims. The examiner also notes that the type of composite elected for a species was a coating claim 11 claims the composite in the form of a filament, claim 12 claims the composite in the form of a foil, claim 13 claims composites in the form of powders and granulated materials, therefore these claims are not searchable from the election of species by the applicant, so the examiner will only search claim 14 which is dependent on claims 1 and 3.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Whitbourne et al. (US 6,110,483).

Whitbourne teaches medical devices that may/are coated with a liquid coating composition that comprises cross-linkable hydrophobic stabilizing polymers and combinations with hydrophilic polymers (including PEG), bioactive agents (including gentamicin a known aminoglycoside antibiotic) and other polymer in addition to the stabilizing polymer (including PVC). See col 1 lin 65-col 2 lin 13, col 7 lin 31-40 and col 8 lin 59-col 9 lin 5. The solution or liquid coating composition is prepared in solvents including cyclohexanone and is removed by evaporation. See col 3 lin 14-19 and col 9 lin 42-49. Whitbourne teaches several ways in which the coating may be applied by various techniques including dip, pour, pump, spray, brush, wipe, or other methods known to those in the art. See col 7 lin 20-24. Regarding the limitation in claim 14 that the composite is formed by compressing, extruding and rolling to give shaped objects, coatings and foils, does not further limit the claim as this is a product by process claim, "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Conclusion

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'mhartley', with a large, stylized flourish extending from the end.

MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER